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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,286	04/20/2001	Jacques Dumas	BAYER-14	9096

23599 7590 10/10/2003

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EXAMINER

KWON, BRIAN YONG S

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 10/10/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/838,286

Applicant(s)

DUMAS ET AL.

Examiner

Brian S Kwon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26, 39-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 26, 39-74 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgment is made of applicants filing of the instant application as Request for Continued Examination (RCE) under 37 C.F.R. 1.114. This application is a CIP of 09/778,039 filed 02/07/2001 which is a CIP of 09/425,229 filed 10/22/1999, abandoned, which is a CON of 09/257,265 filed 02/25/1999, abandoned, which claims benefits of 60/115,878 filed 01/13/1999.

### ***Information Disclosure Statement***

2. Acknowledgement is made of applicant's submitting of the information disclosure statement (IDS) on July 09, 2003. In the Information Disclosure Statement by Applicant, applicants made references to documents (A-S, AM-BB, BC-BM). With respect to documents A-H, no publications (nor the title of article) have been submitted for the examiner to determine the relevance of the document. With respect to documents I-S, AM-BB and BC-BM, applicants reference to "Notice of Reference Cited" from the USPTO for the U.S. application and the European or International search report fails to comply with 37 CFR 1.98(a) (1) and is considered improper. If applicants desire for consideration of the references cited in that particular U.S. application and the European or International search report by the examiner, all patents, publications, or other information should be listed in PTO form 1449. Accordingly, it has been placed in the application file, but the information referred to therein has not been considered.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 26, 39-45, drawn to a compound and composition of p38 kinase inhibitors.
- II. Claims 46-74, drawn to a process of treating a disease mediated by p38 kinase with said compound and composition.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different products (e.g., many of the claimed conditions can be treated with NSAIDS, COX-2 inhibitors, steroids, cyclosporin, methotrexate, etc...). Furthermore, the product as claimed can be used in materially different process of using that product (e.g., herbicidal activity).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. The claims are generic to a plurality of disclosed patentably distinct species comprising (i) various urea derivatives and (ii) various disease states. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (for instance, the specific urea derivative from Tables in pages 67-74 and the specific disease (or related disease states) from various disease states disclosed in page 6, line 27 thru page 7, line 23 of the instant specification) from under the instant claims of the elected Group. Moreover, whatever specific compound and disease state(s) are ultimately elected, applicants are required to list all claims readable thereon.

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With the election of a specific exemplified compound and disease states, a generic concept will be identified by the examiner as the inventive group for examination.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (703) 308-5377. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax number for this Group is (703) 308-4556.

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Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Brian Kwon

**ZOHREH FAY**  
**PRIMARY EXAMINER**  
**GROUP 1600**

A handwritten signature in cursive script, appearing to read "Zohreh Fay", written in black ink.